IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Ronaldus H. T. Oosterholt et al.

SERIAL NO. : 09/741,926   EXAMINER : Peng Ke

FILED : December 20, 2000   ART UNIT : 2174

FOR : DEVICE FOR PRESENTING INFORMATION UNITS

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
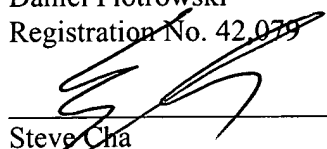Alexandria, VA 22313-1450

Sir:

    In Response to the "Notice of Non-Compliant Appeal Brief" dated March 23, 2006, Applicants enclose Appeal Brief originally submitted on June 3, 2005 with corrections deemed to be non-compliant.

    No additional fees are believed to be necessitated by the foregoing amendment. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 502-470 for any underpayment, or credit any overages.

Respectfully submitted,
Daniel Piotrowski
Registration No. 42,079

Date: April 7, 2006   By: Steve Cha
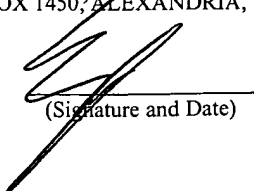   Attorney for Applicant
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application

Inventor	:	Ronaldus Hermanus Theodorus Oosterholt et al.
Application No.	:	09/741,926
Filed	:	December 20, 2000
For	:	DEVICE FOR PRESENTING INFORMATION UNITS

APPEAL BRIEF

On Appeal from Group Art Unit 2174

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Date: April 7, 2006   By: Steve Cha
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TABLE OF CASES

I.   REAL PARTY IN INTEREST

The real party in interest is the assignee of the present application, U.S. Philips

Corporation, and not the party named in the above caption.

II.   RELATED APPEALS AND INTERFERENCES

With regard to identifying by number and filing date all other appeals or

interferences known to Appellant which will directly effect or be directly affected by or

have a bearing on the Board's decision in this appeal, Appellant is not aware of any such

appeals or interferences.

III.   STATUS OF CLAIMS

Claims 1-14 have been presented for examination. All of these claims are

pending, stand finally rejected, and form the subject matter of the present appeal.

IV.   STATUS OF AMENDMENTS

In response to the patent application, which is the subject of this appeal, filed on

December 20, 2000, a first Office Action was mailed on June 19, 2003. The Office

Action rejected claims 1-12 under 35 USC §102(e) as being anticipated by Horvitz (USP

no. 6,067,565).

On August 8, 2003, a response to the first Office Actions was timely filed that

presented arguments why the reference cited failed to anticipate the claimed invention.

Amendments were made to claim1, 7, 10, 11, and 12 to move clearly state the invention

and to correct errors in form. On October 22, 2003, a second and Final Office Action

was entered, which again rejected claims 1-12 as being anticipated by Horvitz, citing the same reasons for rejecting the claims as in the prior Office Action.

On December 3, 2003, a response to the second and Final Office Action was filed which presented additional arguments as to why the claimed invention was not anticipated by the recited reference. Claims 1 and 7 were amended to include the claim element "wherein the compiled set of references includes both previously viewed and un-viewed units." New claims 13 and 14 were added.

On December 24, 2003, an Advisory Action was issued which stated that the amendment made to the claims raised new issues that would require further consideration. On January 20, 2004, a Request for Continued Examination was filed, which requested that the amendments made in the response mailed on December 3, 2003, be entered and the application be reconsidered in view of the amendments made to the claims.

On April 7, 2004, an Office Action, responsive to the Request for Continued Examination, was mailed which indicated the amendments to the claims, and new claims 13 and 14, were entered. The Office Action further stated that claims 1-14 were rejected under 35 USC §103(a) as being unpatenable over Horvitz in view of Kulkarni (USP no. 6,310,630). A response to the Office Action was timely filed on July 7, 2004, which amended claims 1-14 to correct errors in form.

On November 13, 2004, a second and Final Office Action was mailed which again rejected claims 1-14 under 35 USC 103(a) as being unpatenable over Horvitz in view of Kulkarni. On December 17, 2004, a response to the second and Final Office

action was filed that presented additional arguments as to why the claimed invention was

not rendered obvious by the recited references.

On February 22, 2005, an Advisory Action was entered into the file which

maintained the rejection of the claims and provided further explanation regarding the

reason for rejecting the claims citing the same references.

A Notice of Appeal, with appropriate fee, was filed on March 3, 2005. This

Appeal Brief is being filed, with appropriate fee and a request for one month extension,

after the filing of the Notice of Appeal.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

The instant invention relates to a device (claim 1), a method (claim 7) and a

computer product (claim 12) for presenting information units to a user. The device

recited in claim 1 comprises history means for storing references to presented information

units into a history list, wherein the complied set of references includes both previously

viewed and un-viewed information items. The history means comprises user operable

navigation means for changing a current position in the history list and presenting an

information unit referenced by the reference at the current position. The device further

comprises compilation means for user operably compiling a set of references to desired

information units referenced by the compiled set in response to a user operating the

navigation means. (see page 7, lines 12-19). The operation of the invention is disclosed in

more detail with regard to page 6, line 28-page 7, line 11 and Figures 4 and 5, which

state, in part, "Figure 4 illustrates the result of compiling a set of references to web pages

X, Y, and Z, starting from the situation depicted in Figure 3 [which shows references to

web pages A, B, C, and D]. The references to said pages are included into the history list in the same order and the current position is changed to the reference to page X. Hence, in the new situation page X is displayed and pressing the backward button would cause the current position to shift backward to the reference to page D, causing page D to be displayed. Pressing the forward button ...would cause page Y to be displayed for the first time [i.e., page Y was previously unviewed], and pressing the forward button once again would cause page Z to be displayed for the first time.... Figure 5 shows the result of selecting an additional page E ... The page E may be selected by, for example, clicking a link included in the page X, [or] by explicitly entering a new web address ... The newly included reference to page E breaks the connection between the references of the complied set X, Y, Z, but the references to pages Y and Z are not removed from the history list at least until they have been presented once." With regard to claim 7, this claim recites a method for presenting information units to a user comprising a user compiling a set of references to desired information units that are viewed and un-viewed and storing the set of references according to the time of inclusion into a history list to and presenting an information in response to a user changing the current position of the information unit among the set of references. Independent claim 12 recites a computer program product which when executed on a computing devices executes the step recited in claim 7.

VI.   GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

The issue in the present matter is whether:

1. Claims 1-14 are rendered obvious under 35 USC §103(a) by the combination of Horvitz and Kulkarini.

VII.   ARGUMENT

I. Rejection of claims 1-14 Under 35 USC §103(a)
in view of Horvitz and Kulkarni

Claims 1-14 stand rejected under 35 USC 103(a) as being unpatentable over the combination of Horvitz and Kulkarni. The second Advisory Action states that the reason for the maintaining the rejection in view of the applicant's prior remarks is that "A) Horvitz encourages the use of his teachings in other contexts (col. 45, lines 1-10). Therefore, it would not be illogical to use Horvitz's method of viewing a list of web pages for viewing a list of web pages that are previously viewed by the user; B) applicant argues that Horvitz failed to teach storing the web pages on client's computer permanently … the feature … is not recited in the rejected claims; [and] C) applicant argues that because Horvitz and Kulkarni individually fail to disclose the elements recited in the claims…one cannot show nonobviousness by attacking references individually where the rejections are based on combination of references." (see Advisory Action, page 2).

Difference Between the Claimed Invention
and the Cited References

The instant invention, as recited in claim 1, which is typical of the remaining independent claims, discloses a device for presenting information units comprising a history means for storing references to presentable information units into a history list, the history means comprising: user operable navigation means for changing a current position in the history list and presentation means for presenting an information unit referenced by the reference at the current position and compilation means for user operably compiling a set of references to desired information units, wherein the compiled set of references includes both previously viewed and un-viewed information units and storing the references according to the time of their inclusion into the history list.

Horvitz, on the other hand, teaches a technique for prefetching a web page of potential **future interest** that may be subsequently selected by the user or that contain content that may be of future interest to the user based upon current and/or prior interaction of the user. In the teachings of Horvitz, a probabilistic or statistical user model is used to prefetch information including, for example, web pages, wherein when viewing a first web page, the user probabilistic model interprets the links on the currently viewed web page and downloads information associated with the most-likely links of interest to the user based on the user model. Horvitz further discloses that the probabilistic user model is based on factors such as "content and structure of [a] particular web page, a history of web pages visited by the user, [the] user background and user actions" (see col. 1, lines 20-22). The user model is discussed in more detail in col. 4, lines 10-17, which state in part, "[t]he user model can rely on, e.g., a function(s) of current page structure and content, recent sequences of pages downloaded to the user,

descriptions of long-term or short-term interest of the user, user background, the behavior of the user in interacting with the computer or previously downloaded content and one or more usage statistics available from a server or from the user's computer."

The pre-fetching or prediction of future, web pages is also discussed in col. 8, lines 39-50, which state, in part, "[t]he particular pages that are pre-fetched are determined through a user model as being those, given a page which a user is currently viewing or a sequence of pages visited, would provide the largest benefit [to the user]... In that regard, the model provides a URL for each page in a set of pages and a corresponding estimate of the likelihood that during a current session, a user will access each of those particular pages for viewing. Furthermore, "[a]s successive web pages are selected by the user and displayed, the user model is updated through consideration of the current page; thereafter new pages may be prefetched and so on." (see col. 9, lines 4-6). Hence, the method of pre-fetching web pages for **future access** by the user does not consider maintaining a list of previously viewed pages as is inferred by the examiner. But rather, uses information of previously viewed pages to refine the user model. There is no mention that the pages themselves are retained in a time sequence.

Accordingly, contrary to the statements made in the Final Office Action, Horvitz fails to disclose material elements of the invention as recited in claim 1, for example. More specifically, Horvitz fails to teach or suggest "a history list," "user operable navigation means for changing a current position in the history list," or "compiling a set of reference ... includ[ing] both previously viewed and un-viewed information items and storing the references ... according to the time of their inclusion into the history list," as is recited in the claim.

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The Office Action states that a history list may be inferred from the Horvitz model. However, Horvitz fails to teach or suggest a history list. Rather Horvitz teaches using previously viewed pages to refine the user model and provides no teaching or suggestion of maintaining a history list of elements (stored in a time sequence), which may be individually viewed.

Horvitz also fails to teach or suggest any "user operable navigation means for changing a current position" as is recited in the claim. Rather, Horvitz teaches using a back and forward button on the web browser, which the Office Action infers is the same as "operable navigation means," recited in the claims. However, the conventional back and forward web buttons does not process a list that is sorted in a time sequence or allow for changing a "current position" in the list. Accordingly, use of the back and forward browser buttons described by Horvitzis is not the same as "operable navigation means for changing a current position," as is recited in the claims.

Kulkarni discloses a data processing system for generating browser histories, wherein visited pages are stored in inverse chronological order (see col. 6, lines 45-46.) However, Kulkarni merely discloses a conventional means for storing and formatting visited web pages. Kulkarni fails to disclose or suggest a "user operable navigation means for changing a current position in the history list" or that the history list includes "viewed and un-viewed information units," as is recited in the claims.

No Motivation Exists for the
Examiner's Proposed Modification

The law is clear that there must be some teaching in the reference to support their use in the particular claimed combination. See Smithkline Diagnostics, Inc., v. Helena Labs Corp., 859 F.2d 878, 887, 8 USPQ 2d 1468, 1475 (Fed. Cir. (1988). Contrary to the statements made in the Final Office and Advisory Actions, there is no motivation to develop the features of the present invention from the teachings of the cited references.

As shown, Horvitz fails to disclose or suggest subject matter recited in claim 1, for example. Nothing in Horvitz discloses either maintaining references in a time oriented history list or user operable navigation means for changing a current position in the history list. Rather, the maintenance of a history list, as is stated in the Office Action, is inferred and not disclosed. Horvitz provides no motivation to maintain such a list as Horvitz uses the data in the prior viewed pages to refine the user model and does not require that prior web pages be maintained. Kulkarni teaches storing web pages in inverse chronological order

.   Hence, there is no motivation to combine the teachings of the cited references as Horvitz fails to teach storing web pages and Kulkarni teaches their storage in reverse order.

.   With regard to obviousness applicant submits that "[t]he very ease with which the invention can be understood may prompt one to fall victim to the ... effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Iron Grip Barbell Company v. USA Sports, Inc., Docket no. 04-1149, Dec. 14, 2004, p. 4, (Fed.Cir. 2004), (quoting In re Kotzab, 217 F.3d 1365, 1369 (Fed. Cir. 2000). "Where an

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invention is contended to be obvious ... our cases require that there be a suggestion, motivation or teaching ... for such a combination." *Id.* at 5 (quoting In re Fine, at 1074 (Fed. Cir. 1988). "This requirement prevents the use of 'the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentablility -- the essence of hindsight.'" *Id.* (quoting Ecolochem, Inc. v. So. Cal. Edison Co., 227 F.3d 1361, 1371-1372 (Fed. Cir. 2000), quoting In re Dembiczak, 175 F. 3d 994, 999 (Fed. Cir.1999)).

In this case, applicant believes that because an inference is made that the Horvitz teaches a history list, then the Horvitz and Kulkarni references have been impermissibly combined using the teachings of the instant application as a blueprint without any suggestion or reason for such combination from either reference.

Applicant , thus submits that no motivation exists to combine the teachings of the references as stated in the Office Action and that the independent claims 1 and 7 are not rendered obvious by the combination of Horvitz and Kulkarni.

With regard to the dependent claims, these claims are dependent from independent claims 1 and 7 and, hence, are not rendered obvious by virtue of their dependency upon an allowable base claim.

For at least all of the above reasons, the proposed combination of prior art references fails to render obvious the present invention.

Proposed Modification of Horvitz by Kulkarni
Fails to Arrive at the Present Invention

It is respectfully submitted that it was held by *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) that in order to establish a *prima facie* case of obviousness, three basic criteria must be met;

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;

2. there must be a reasonable expectation of success; and

3. the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

With regard to the invention as recited in claim 1, Applicant respectfully submits that none of the three basic criteria have been met, thus a *prima facie* case of obviousness has not been set forth.

As shown above, Horvitz fails to disclose a history list and both Horvitz and Kulkarni fais to disclose or suggest a "user operable navigation means for changing a current position in the history list" or that the history list includes "viewed and un-viewed information units," as is recited in the claims. Accordingly, even if there were some motivation to combine the teachings as suggested, the combined device would not include all the elements claimed.

Applicant respectfully submits that the combined teachings of the references cited fails to rendered obvious the subject matter recited in independent claims 1 and 7.

With regard to the dependent claims, these claims are dependent from independent claims 1 and 7 and, hence, are not rendered obvious by virtue of their dependency upon an allowable base claim.

For at least all of the above reasons, the proposed combination of prior art references fails to render obvious the present invention

In view of the above analysis, it is respectfully submitted that the referenced teachings, whether taken individually or in combination, fail to render obvious the subject matter of any of the present claims. Therefore, reversal of all outstanding grounds of rejection is respectfully solicited.

Respectfully submitted,

Daniel J. Piotrowski
Registration No. 42,079

Date: April 7, 2006

By: Steve Cha
Attorney for Applicant
Registration No. 44,069

VIII. CLAIMS APPENDIX

The claims which are the subject of this Appeal are:

1. A device for presenting information units, comprising history means for storing references to presentable information units into a history list, the history means comprising:

   user operable navigation means for changing a current position in the history list, and

   presentation means for presenting an information unit referenced by the reference at the current position, and

   compilation means for user operably compiling a set of references to desired information units, wherein the compiled set of references includes both previously viewed and un-viewed information units, and storing the references of said set according to the time of their inclusion into the history list so as to present an information unit referenced by the compiled set in response to a user operating said navigation means.

2. The device as claimed in claim 1, wherein the navigation means comprising:

   forward means for changing the current position in the history list to a reference stored more recently than the reference at the current position, the presentation means being adapted to present respective information units referenced by the compiled set in response to the user iteratively operating said forward means.

3. The device as claimed in claim 1, wherein the compilation means being adapted to impose a user supplied order on the compiled set of references, and store the references into the history list in accordance with said order.

4. The device as claimed in claim 1, further comprising:

bookmark means for storing a bookmark to the compiled set of references, and

storing the references of said set into the history list in response to the user selecting said bookmark.

5. The device as claimed in claim 1, wherein the information units being retrieved from a remote server, the compilation means being adapted to start retrieving information units referenced by the compiled set independently of an operation of the navigation means.

6. The device as recited in claim 1, wherein said device is an internet access terminal.

7. A method of presenting information units, comprising a step of storing references to presented information units into a history list, a step of user operably changing a current position in the history list and presenting an information unit referenced at the current position, further comprises the steps of:

user operably compiling a set of references to desired information units, wherein the compiled set of references includes both previously viewed and un-viewed information units, and

storing the references of said set according to the time of their inclusion

into the history list so as to present an information unit referenced by the compiled set in

response to a user changing the current position in the history list.

8. The method as claimed in claim 7, further comprising the steps of:

user operably changing the current position to a reference stored more

recently than the reference at the current position, and

presenting the information units referenced by the compiled set in

response to the user iteratively performing said forward moving step.

9. The method as claimed in claim 8, further comprising the steps of:

imposing a user supplied ordering on the compiled set of references, and

storing the references into the history list in accordance with said ordering.

10. The method as claimed in claim 7, further comprising the steps of:

storing a bookmark to the compiled set of references, and

storing the references of said set into the history list in response to the

user selecting said bookmark.

11. The method as claimed in claim 7, wherein the information units being retrieved from

a remote server, the method further comprising the step of:

retrieving information units referenced by the compiled set independently

of an operation of the navigation means.

12. A computer program product for performing, when executed on a computing device, the method as claimed in claim 7.

13. The device as claimed in claim 1, wherein a first information unit referenced by the compiled set is presented immediately.

14. The method as claimed in claim 7, further comprising a step of:

immediately presenting a first information unit referenced by the complied set.

IX.   EVIDENCE APPENDIX

Figures 4 and 5 of the instant application are referred to in the Summary of the

Invention and are included herein for the convenience of this Honorable Board.

X.   RELATED PROCEEDING APPENDIX

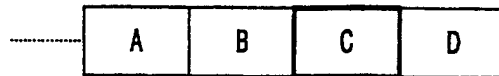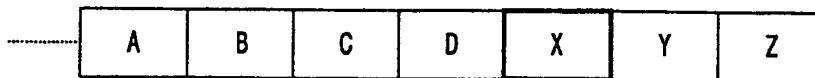No related proceedings are pending and, hence, no information regarding same is

available.

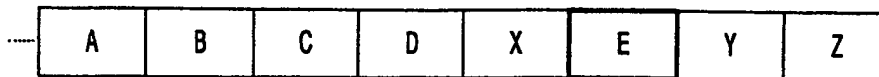| A	B	C	D

FIG. 3

A	B	C	D	X	Y	Z

FIG. 4

A	B	C	D	X	E	Y	Z

FIG. 5